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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,535	06/06/2001	Jun Shan Wey	004524.P030	7583

7590

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EXAMINER

DUVERNE, JEAN F

ART UNIT

PAPER NUMBER

2839

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/876,535

Applicant(s)

Wey et al

Examiner

Jean Duverne

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 6, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 U.S.C. 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakajima et al (JP patent 361233706A).

In regard to claim 1, Nakajima's device discloses a mode scrambler (see abstract) comprising a first and second end wherein a single mode optical fiber at 42 is coupled to the first end and a multi-mode optical fiber at 44 coupled to the second end; and a defuser (14) placed in a gap between the single mode and the multi-mode optical fibers.

In regard to claim 9, Nakajima's device discloses the aforementioned limitations except for the method to scramble an optical signal. Nevertheless, the features recited in the method claims are identical to the limitations in the apparatus claims mentioned above: the method to scramble an optical signal is not germane to the issue of patentability of the device itself. It is considered as an inherent features. Therefore, this limitation has not been given any patentable weight

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***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-8, 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima et al (JP patent 361233706A).

In regard to claims 2-8, Nakajima's device discloses the aforementioned limitations but fails to explicitly disclose the material of which the defuser is made of. It would have obvious to one having ordinary skill in the art at the time the invention was made to use the defuser made with different type of materials, since it has held to be within the general skill of a worker in the art to select known material on the basis of its suitability for the intended use as a matter to meet system design and requirement. In re Leshin, 125 USPQ 416.

In regard to claims 10-16, Nakajima's device discloses the aforementioned limitations except for the method to scramble an optical signal. Nevertheless, the features recited in the method claims are identical to the limitations in the apparatus claims mentioned above: the method to scramble an optical signal is not germane to the issue of patentability of the device itself. It is considered as an inherent features. Therefore, this limitation has not been given any patentable weight.

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***Conclusion***

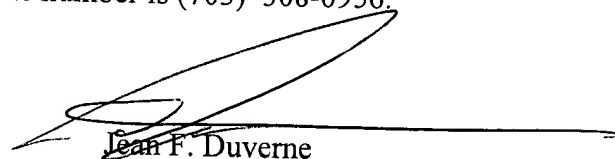
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean Duverne whose telephone number is (703) 305 - 0297 . The examiner can normally be reached from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild, can be reached on (703)308-2710. The fax phone number for this Group is (703) 308 - 7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

JFD

January 12, 2003



Jean F. Duverne

Patent Examiner, Art Unit 2839